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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,825	09/04/2003	Wayne J. Falcon	34321.3	5170

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HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

EXAMINER

ALIMENTI, SUSAN C

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/654,825

Applicant(s)

FALCON, WAYNE J.

Examiner

Susan C. Alimenti

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5,6,9,12,16,19,20,24,29-32,37,38,41,44,49,55 and 56.

Continuation of Disposition of Claims: Claims rejected are 1- 4, 7, 8, 10, 11, 13-15, 17, 18, 21-23, 25-28, 33-36, 39, 40, 42, 43, 45-48, 50-54, 57-67, and 69-71.

DETAILED ACTION

Election/Restrictions

1. Claim 20 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 28 July 2004.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1- 4, 7, 8, 10, 11, 13-15, 17, 18, 21-23, 25-28, 33-36, 39, 40, 42, 43, 45-48, 50, 52-54, 57-61, 63, 65, 70 and 71 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill (US 2,185,666).

Hill discloses an upper weighted hook for partial embedment in a plastic fishing lure comprising a hook shank 7, a bend 8 at one end leading into a reverse bend 8A (See examiner's reference characters, Figure 1), and an eye 5 provided in the opposite end. The reverse bend 8A terminates in a tip or point 9, which is spaced from barb 9A. A double-tapered weight 11 comprises a lower weight taper 11A and a top weight taper 11B, both tapered to the shank 7, where the top weight taper 11B is closer to the eye 5 than to the tip 9. The hook shank 7 is *substantially* (emphasis added) straight from said bend 8 at least to the top weight taper 11B. An offset bend 14 is provided in said shank 7 between said weight 11 and eye 5. A lure 15 is

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embedded at least partially on said reverse bend 8A, and said lure 15 is alongside said reverse bend 8A, barb 9A, and tip 9.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 51, 62, 64 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill as applied to claims 33, 39, 42, 47, 53, and 59 above, and further in view of Grigsby (US 5,335,443).

Hill discloses the claimed invention except the lure 15 is not expressly shown to be embedded on the barb 9A, hook tip 9, and/or hook eye 5. Grigsby discloses a similarly shaped, weighted lure hook having a fishing lure 20 that is embedded on the tip, barb 19 and hook eye 17. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place a lure on Hill's hook so that it is embedded on the tip, barb and hook eye, since it has been held that the mere rearrangement of parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

6. Claims 33, 67, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoben (US 6,691,449), and further in view of Hill.

Hoben discloses the claimed hook structure except it is not made in combination with a tapered weight, and a lure body is not expressly shown. Hoben's hook, as best viewed in Figure 3, comprises a hook, a hook shank 16, a hook tip, a hook eye 14, a shank offset bend 30, a shank offset, a shank neck bend 32, and a shank neck terminated by said eye 14. While Hoben does not disclose a weight, it is a well-known addition to a fishing hook to assist in control of the hook in a variety of ways. Hill discloses a similarly shaped hook that utilizes a tapered weight 11 that serves to control the hook and attached bait 15 as it is being drawn through the water, by holding it below the water level and preventing spinning (Hill, claim 2, lns.10-13). It would have been obvious to one having ordinary skill in the art to modify Hoben's worm hook by adding Hill's tapered weight in order to control position and motion of said hook.

Regarding the lure body, even though it is not shown Hoben notes that the embodiment of Figure 3 is specifically for wide gap worms (Hoben, col.1, ln.60).

Regarding claim 69, it is well known to attach a lure to a hook so as not to embed the hook eye, offset bend and the weight.

Allowable Subject Matter

7. Claim 68 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments with respect to claims 1-71 have been considered but are moot in view of the new grounds of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 703-306-0360. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 703-305-7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SCA

A handwritten signature in black ink, appearing to read 'Teri Luu', with a stylized flourish at the end.

TERI PHAM LUU
SUPERVISORY
PRIMARY EXAMINER

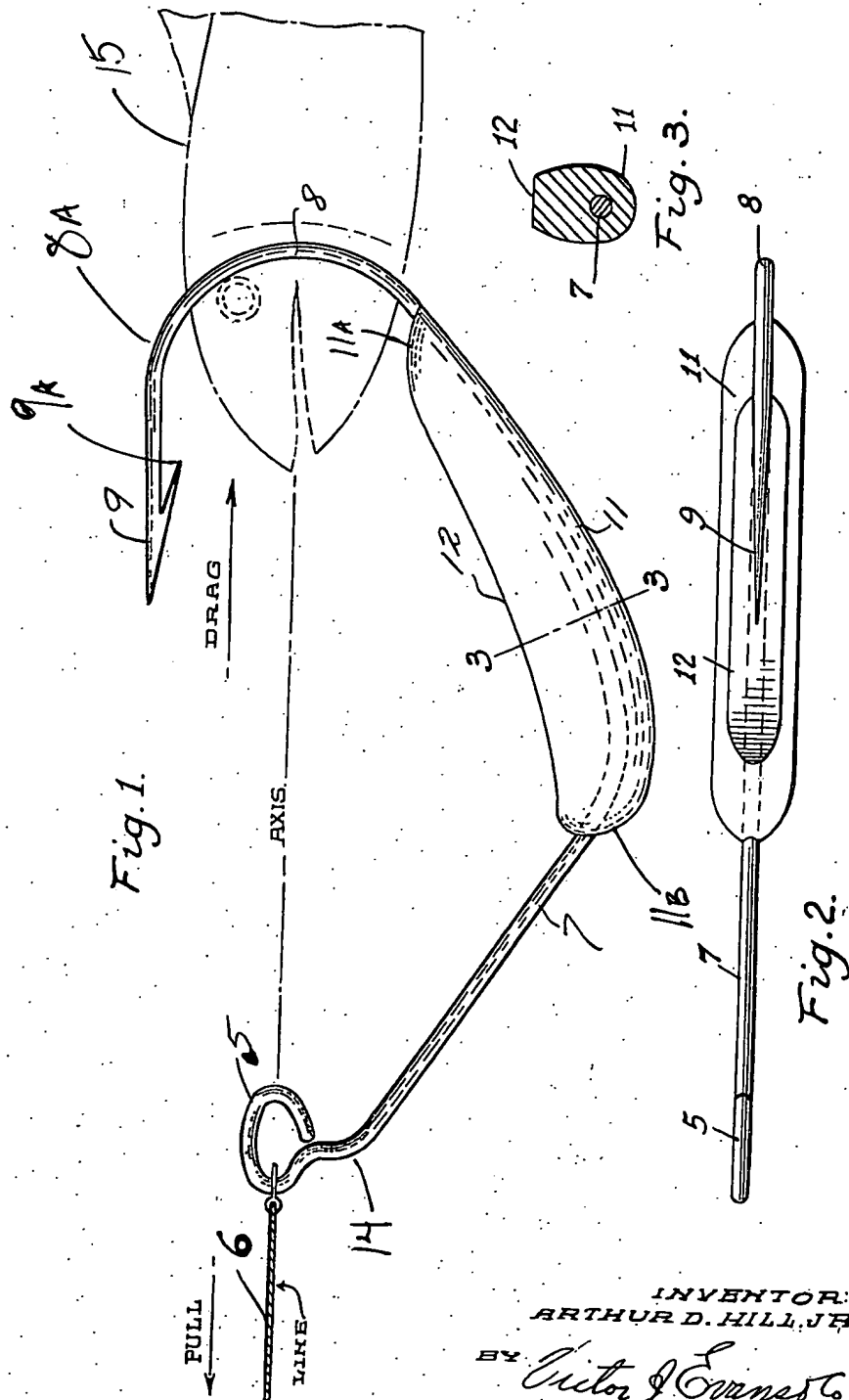
Jan. 2, 1940.

A. D. HILL, JR

2,185,666

FISHING GEAR

Filed Jan. 25, 1938



INVENTOR:
ARTHUR D. HILL, JR.
BY *Victor J. Earnest*
ATTORNEYS

UNITED STATES PATENT OFFICE

2,185,666

FISHING GEAR

Arthur D. Hill, Jr., Los Angeles, Calif.

Application January 25, 1938, Serial No. 186,869

2 Claims. (Cl. 43-54)

This invention relates to improvements in fishing gear and has particular reference to a trolling hook.

The principal object of this invention is to provide a trolling hook upon which bait may be placed, such as a small fish, and when the same is drawn through the water, the bait fish will have the appearance of swimming, so that it acts as a lure in catching larger fish.

A further object is to provide means whereby the drawing of the line through the water will maintain the fish in an upright position and upon a substantially even keel.

A still further object is to provide means to prevent the bait fish from spinning about the axis of the drawing line.

A further object is to produce a device of this character which is economical to manufacture, and simple to employ.

Other objects and advantages will be apparent during the course of the following description.

In the accompanying drawing forming a part of this specification and in which like numerals are employed to designate like parts throughout the same,

Figure 1 is a side elevation of my device, as the same would appear in use.

Figure 2 is a top plan view thereof, and Figure 3 is a vertical sectional view taken on the line 3-3 of Figure 1.

In fishing, particularly in trolling, it is the object of the fisherman to employ a lure which will simulate the movement of a fish in a life-like manner. As the trolling is often done from a boat which moves at a relatively rapid rate of speed, the bait fish being drawn behind the boat has a tendency to spin, which quickly ruins a line and also thwarts the purpose of the lure, namely, naturalness.

I have, therefore, devised a trolling hook which consists of an eye 5, to which the line 6 is attached. This eye 5 is bent to form a downwardly extending shank 7 which is curved as at 8 and terminates in a barb 9. The bait fish, shown in broken lines, is secured upon the curved portion 8, and between this curved portion and the shank 7 I place a weight 11, having a rela-

tively flat surface 12, which surface is inclined downwardly from the curved end toward the shank.

The result of this construction is that when the line 6 is moved through the water, the shape of the bait fish and the pull of the line on the water tends to lift the hook and bait out of the water. However, the downwardly extending surface 12, which is contacted by the water passing thereover, tends to counteract this upward pull just described and maintains the hook and bait below the surface and in the proper position, so that the bait fish appears to be moving through the water in a normal manner and is, therefore, an attractive lure to a larger fish.

It is to be understood that the form of my invention herewith shown and described is to be taken as a preferred example of the same and that various changes relative to the material, size, shape and arrangement of parts may be resorted to without departing from the spirit of the invention or the scope of the subjoined claims.

Having thus described my invention, I claim:

1. A trolling hook of the class described embodying a shank having an eye formed at one end thereof, said shank extending downwardly and angularly from said eye and thence curved upwardly and inwardly toward the eye and terminating in a barb, and a flattened weight positioned upon said curved section of the shank and inclined downwardly toward the angularly disposed section of said shank.

2. A trolling hook of the class described embodying a shank having an eye formed at one end thereof, said shank extending downwardly and angularly from said eye and thence curved upwardly and inwardly toward the eye and terminating in a barb, and a weight positioned upon said curved section of the shank and inclined downwardly toward and terminating at the juncture of the angularly disposed and curved sections of the shank, said weight having a flat upper surface, whereby when the hook is drawn through the water it will be held below the surface and be prevented from spinning.

ARTHUR D. HILL, Jr.